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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of:	Brian Gingras et al.
Appln. No.:	09/900,746
Filed:	July 6, 2001
For:	Method for Wetting and Winding a Substrate

Examiner: Kirsten C. Jolley
Art Unit: 1762

Attorney Docket No: 659/791 (KC 14972A)

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL

Sir:

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☒ Appeal Reply Brief
☒ Return Receipt Postcard

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First Presentation of Multiple Dep. Claim						+$180=			+ $360=	
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☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

Amanda M. Church

September 26, 2005
Date

Amanda M. Church (Reg. No. 52,469)

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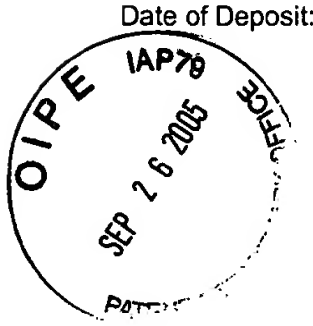


Our Case No. 659/791
K-C Ref. No. 14972A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
Brian Gingras et al.	
Serial No. 09/900,746	Examiner Kirsten C. Jolley
Filing Date: July 6, 2001	Group Art Unit No. 1762
For METHOD FOR WETTING AND WINDING A SUBSTRATE	

APPEAL REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Appeal Reply Brief is in response to the Examiner's Answer dated July 26, 2005.

I. ARGUMENT

A. Claims 1-7, 9-12, 14, 16-19, and 21-48 are not obvious under 35 USC § 103 over WO 01/40090 A2 to Perini because Perini does not teach or suggest each and every element of the claimed invention.

The Examiner asserts that even though Perini teaches that the presence of moisture or liquid would make the changeover "difficult," that this is not necessarily a statement that the results would be unsatisfactory. (Examiner's Answer, p. 10-11). First, Appellants note that Perini actually teaches that it would be difficult, if not **impossible**, to effect the changeover if moisture or liquid were present. Indeed, this is a strong indication that the applicants of Perini, presumably ones skilled in the art, would have expected these results to be unsatisfactory. Regardless, this is a very good example of a reference teaching away from a claimed invention. Appellants cannot fathom a situation where one of skill in the art would read Perini and expect that a successful changeover could be accomplished by attempting to break a web of material after it is wetted.

Moreover, for a rejection to be proper under 35 U.S.C. §103, there must be, either in the reference or in the state of the art, a motivation to modify the cited reference to read on the claims of the instant application. And, if a proposed modification would render the prior art invention unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP § 2143.01.

Perini does not teach or disclose breaking a wet web, as claimed by Appellants. Therefore, there must be some motivation to modify the reference to include each and every element of the claimed invention under § 103. The Examiner fails to provide the needed motivation to modify Perini that would provide a *prima facie* case of obviousness. Certainly, a teaching that something would not work for its intended purpose, what the Examiner calls a "negative teaching," would not provide the required motivation or suggestion to modify. Therefore, Appellants request this rejection be withdrawn.

B. Claims 1-7, 9-19, and 21-30 are not obvious under 35 USC § 103 over U.S. Patent No. 4.601,938 to Deacon because Deacon does not teach or disclose each and every element of the claimed invention.

The Examiner asserts that the term "breaking" includes the action of slitting because breaking includes any step of separating into two parts. Appellants disagree. The term "breaking" as used in Appellants' specification and claims should not be read so broadly as to include the act of separating a web of material in the machine direction (MD), slitting. One of ordinary skill in the art would recognize the difference between these two terms. Deacon does not teach "breaking" a wet web, and therefore does not teach or suggest each and every element of the claimed invention. For this reason alone, Appellants request this rejection to be withdrawn.

The public notice function of the patent claims is better served by looking to the patentee's use of the term in the specification of the patent. Therefore, the use of the term in the specification as the action of creating a leading edge connected to the trapped portion of the web by pulling the web back or stalling the web on the smooth insert, separating, or breaking, the perforation (p. 24, l. 14-30), should be given deference.

Furthermore, the Examiner mentions that it was known in the art to create smaller rolls from larger rolls of material and therefore, in view of the knowledge in the art and the wet roll of Deacon, the claimed invention would obvious. Appellants disagree. First, the Examiner provides no reference or affidavit to support this argument. Secondly, while it may have been known to create smaller rolls of web from larger rolls of web by breaking the web while it was dry, as in Perini, it would not have been obvious to create smaller rolls from larger ones by breaking the web while it is wet. This is true especially in view of the teachings of Perini. Therefore, this argument too must fail.

C. Claims 13, 15 are not obvious under 35 USC § 103 over WO 01/40090 A2 to Perini in view of U.S. Patent No. 4.601,938 to Deacon because neither reference teaches or discloses each and every element of the claimed invention.

As discussed above, one of ordinary skill in the art, reading Perini, would not be motivated to modify the reference to include breaking a wet web. Therefore, it would

not have been obvious, as argued by the Examiner, to use the wet substrate taught by Deacon as the web material in the process of Perini (Examiner's Answer, p. 13). This is much like the argument made by the Examiner that because it was known to make smaller rolls of web from larger ones, it would have been obvious to use the wet roll of Deacon to create smaller rolls. (Examiner's Answer, p. 12) As stated above, there is no suggestion or motivation in the references cited, either alone or in combination, to break a wet web of material, thereby creating a smaller roll from a larger one. Therefore, the references do not teach or suggest each and every element of the claimed invention. Appellants respectfully request this rejection be withdrawn.

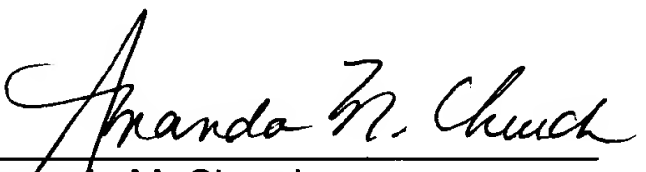
D. Claim 20 is not obvious under 35 USC § 103 over Perini or Deacon, further in view of U.S. Patent No. 5,667,635 to Win because none of the references, either alone or in combination, teach or disclose each and every element of the claimed invention.

As stated above, neither Perini nor Deacon, alone or in combination, teach each and every element of the claimed invention. Win does not provide the needed element or the motivation to combine the references needed for an obviousness rejection to be proper. On this ground alone, Appellants respectfully request this rejection be withdrawn.

II. Conclusion

The cited references, either alone or in combination with the Examiner's assertions, do not provide a valid basis for a *prima facie* obviousness rejection of the present claims. Accordingly, Appellants submit that the present invention is fully patentable over Perini, Deacon, and Win and the Examiner's rejection should be REVERSED.

Respectfully submitted,



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